

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD S. RICH

Appeal No. 1999-1751
Application No. 08/814,299¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, NASE and
GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 4 and 30, as amended subsequent to the final rejection. Claims 24 to 29, the other claims pending in this application, have been allowed.

¹ Application for patent filed March 10, 1997.

Appeal No. 1999-1751
Application No. 08/814,299

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a device for transporting workpieces. An understanding of the invention can be derived from a reading of exemplary claims 1 and 30, which appear in the appendix to the examiner's answer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Laverriere 1983	4,389,064	June 21,
Claeskens et al. 1984 (Claeskens)	4,480,780	Nov. 6,
Hawkswell 25, 1986	4,624,050	Nov.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hawkswell.

Claim 30 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Laverriere.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hawkswell in view of Claeskens.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 6, mailed September 2, 1998) and the answer (Paper No. 14, mailed February 4, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed December 24, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation issues

We sustain the rejection of claim 30 under 35 U.S.C. § 102(b) but not the rejection of claims 1 and 2.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claims 1 and 2

These claims recite a device for transporting workpieces including, inter alia, a first vacuum head element, a reciprocating spindle having a helical rack and a helical pinion driven by an output shaft of a rotary motor meshing with the pinion.

The examiner's rejection is based on his belief (answer, pp. 4-5) that the claimed helical rack and helical pinion are readable on Hawkswell's drive nut 38 and lead screw 72, respectively. The appellant disagrees (brief, p. 5).

We find that the claimed helical rack and helical pinion are **not** readable on Hawkswell's drive nut 38 and lead screw 72. In that regard, it is well known that the distinction between helical gearing and worm gearing may be stated as follows: If the number of threads, or teeth, on the pitch cylinder is such that no one thread makes a complete turn, the gear is called a *helical* gear. If on the other hand, a thread makes a complete turn, the result is a *worm* and the mating

gear is called a *worm gear*.² Since Hawkswell's drive nut 38 and lead screw 72 inherently include a thread making a complete turn, it is inappropriate to consider either Hawkswell's drive nut 38 to be a *helical* rack or Hawkswell's lead screw 72 to be a *helical* pinion.

Since all the limitations of claims 1 and 2 are not found in Hawkswell for the reasons stated above, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 102(b) is reversed.

Claim 30

This claim recites a device for transporting workpieces including, inter alia, a first vacuum head element, a reciprocating spindle, a housing having a radially-oriented surface, and a porous foam member overlying the radially-oriented surface wherein the porous foam member conforms to a

² See "Mechanics of Machinery," Third Edition, C. W. Ham and E. J. Crane, McGraw-Hill Book Company, Inc., 1948, pp. 123-127.

surface of an article to be transported upon engagement therewith.

We agree with the examiner's determination (final rejection, pp. 2-3, and answer, pp. 5-6) that claim 30 is anticipated by Laverriere.

We find that the appellant's arguments (brief, pp. 7-8) as to why claim 30 is not anticipated by Laverriere unpersuasive for the following reasons.

First, the appellant argues that Laverriere uses closed cell foam rather than open cell foam. However, claim 30 does not require that the porous foam member be an open cell foam. Moreover, Laverriere clearly teaches that his foam 3 is an open cell foam.³

Second, the appellant argues that suction passes only through the openings 4 of Laverriere's foam 3. However,

³ See, for example, column 3, line 68; column 4, lines 24-25; and column 5, lines 4-15.

Laverriere clearly teaches that his foam 3 permits suction to pass in addition to the openings 4.⁴ Moreover, claim 30 only requires the foam member to be porous, which is met by openings 4 in the foam 3 as well as the foam 3 being an open cell foam.

Third, the appellant argues that Laverriere lacks both the radially-oriented surface and the porous foam member overlying the radially-oriented surface as set forth in claim 30. We do not agree. It is our determination that when the phrase radially-oriented surface is given its broadest reasonable meaning,⁵ that limitation is readable on Laverriere's

⁴ See column 4, lines 29-39.

⁵ It is well settled that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

structure 5 since structure 5 extends radially in all directions from its midpoint. Thus, Laverriere's foam 3 does overly a radially-oriented surface as set forth in claim 30.

Since all the limitations of claim 30 are found in Laverriere, the decision of the examiner to reject claim 30 under 35 U.S.C. § 102(b) is affirmed.

The obviousness issue

We will not sustain the rejection of claims 3 and 4 under 35 U.S.C. § 103.

We have reviewed the reference to Claeskens additionally applied in the rejection of claims 3 and 4 (dependent on claim 2) but find nothing therein which makes up for the deficiencies of Hawswell discussed above regarding claims 1 and 2. Accordingly, we cannot sustain the examiner's rejection of appealed claims 3 and 4 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claim 30 under 35 U.S.C. § 102(b) is affirmed; and the decision of the examiner to reject claims 3 and 4 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 1999-1751 - JUDGE NASE
APPLICATION NO. 08/814,299

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APJ GONZALES

SAPJ McCANDLISH

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 17 Aug 99

FINAL TYPED: